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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,340	07/09/2003	Peter D. Pierce	1779A	1489

7590 04/22/2004  
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EXAMINER

MIGGINS, MICHAEL C

ART UNIT PAPER NUMBER

1772

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/616,340

Applicant(s)

PIERCE ET AL.

Examiner

Michael C. Miggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07092003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 5, 7, 9-13 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Drummond et al. (U.S. Patent No. 6,135,346).

Drummond et al. teach a paper or paperboard core or tube and a method for manufacturing a paper or paperboard core or tube comprising a foamed aqueous adhesive, wherein one or more paper or paperboard materials are bonded together with the adhesive, which is a multi-ply core or tube (column 2, lines 1-24), wherein the core

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or tube is used in the tissue, towel, carpet, textile, plastic film, paper, food, or industrial storage industry, which is a food container (column 1, lines 10-20), wherein said adhesive is selected from the group consisting of polyvinylacetate homopolymer emulsions and copolymer emulsions, polyvinyl alcohol, dextrans, starches, acrylates, silicates, filled systems, crosslinkables and mixtures thereof (column 2, lines 1-24) (applies to instant claims 5, 7, 9-13 and 17).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond et al. (U.S. Patent No. 6,135,346).

Drummond et al. disclose applicant's invention substantially as claimed.

However, Drummond et al. fail to disclose wherein the adhesive is applied to the ply material as the core or tube is wound.

Drummond et al. teach that the adhesive is first applied and then wound (column 6, lines 9-36). It has been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provide simultaneous application of the adhesive while winding in order to reduce production time (applies to claim 15), since

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making a process continuous, absent a showing of unexpected results, involves only routine skill in the art. See MPEP 2144, V, E.

5. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond et al. (U.S. Patent No. 6,135,346) in view of Saidman et al. (U.S. Patent No. 4,983,424).

Drummond et al. disclose the claimed invention except for the amount of foaming recited in claims 6 and 14. However, Saidman et al. teach foaming of a foamed adhesive (column 1, lines 5-16 and column 2, lines 23-49) wherein the amount of foaming can be 33 or 55% by weight (column 4, line 54 through column 5, line 33, since  $DV=M$ ). Thus one of ordinary skill in the art would have recognized that the amount of foaming would be readily determined through routine experimentation depending on the desired end results absent some showing of unexpected results. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the amount of foaming recited in claims 6 and 14 in order to lower production costs due to less adhesive material being used, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges or an optimum value of a result effective variable involves only routine skill in the art (applies to instant claims 6 and 14). See MPEP 2144.

6. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond et al. (U.S. Patent No. 6,135,346) in view of Hattori et al. (JP 53011933A, English translation of abstract provided herein).

Drummond et al. disclose applicant's invention substantially as claimed.

However, Drummond et al. fail to disclose a core or tube which is a single ply core or tube.

Hattori et al. teach a paper core which is a single ply core or tube (see English translation of abstract provided herein) for the purpose of providing lower production costs due to the use of less paper material and foamed adhesive (applies to instant claims 8 and 16).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided a core or tube which is a single ply core or tube in the tube of Drummond et al. in order to provide lower production costs due to the use of less paper material and foamed adhesive as taught or suggested by Hattori et al.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 5-7, 9-15, and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/265,225 in view of Drummond et al. (U.S. Patent No. . (U.S. Patent No. 6,135,346).

Claims 1-4 of copending Application No. 09/265,225 recite a paper or paperboard core or tube and a method comprising an adhesive which has been foamed up to 40% by weight and wherein the core or tube is used in the tissue, towel, carpet, textile, plastic film, paper, food or industrial storage industry (applies to instant claims 5-6, 10 and 13-14).

Claims 1-4 of copending Application No. 09/265,225 fail to recite that the foamed adhesive is an aqueous adhesive as well as the limitations recited in claims 7, 9, 11-15 and 17.

Drummond et al. teach a foamed aqueous adhesive (column 2, lines 1-24) and the limitations recited in claims 7, 9, 11-15 and 17 as discussed above in paragraphs 1-4 for the purpose of providing lower production costs (applies to instant claims 5-7, 9-15, and 17).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided a foamed adhesive is an aqueous adhesive as well as the limitations recited in claims 7, 9, 11-15 and 17 in the tube or

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core recited in claims 1-4 of copending Application No. 09/265,225 in order to provide lower production costs as taught or suggested by Drummond et al..

This is a provisional obviousness-type double patenting rejection.

9. Claims 8 and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/265,225 in view of Drummond et al. (U.S. Patent No. . (U.S. Patent No. 6,135,346), as applied to claims 5-7, 9-15, and 17 above, and further in view of Hattori et al. (JP 53011933A, English translation of abstract provided herein).

Claims 1-4 of copending Application No. 09/265,225 recite applicant's invention substantially as claimed. However, claims 1-4 of copending Application No. 09/265,225 fail to recite a core or tube which is a single ply core or tube.

Hattori et al. teach a paper core which is a single ply core or tube (see English translation of abstract provided herein) for the purpose of providing lower production costs due to the use of less paper material and foamed adhesive (applies to instant claims 8 and 16).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided a core or tube which is a single ply core or tube in the tube of recited in claims 1-4 of copending Application No. 09/265,225 in order to provide lower production costs due to the use of less paper material and foamed adhesive as taught or suggested by Hattori et al.

This is a provisional obviousness-type double patenting rejection.



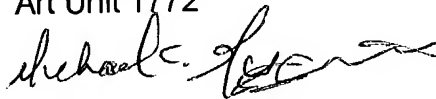
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (571) 272-1494. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael C. Miggins  
Examiner  
Art Unit 1772



MCM  
April 19, 2004